

### Remarks

Applicant has amended independent claims 1 and 13 to overcome the rejection of those claims by the Examiner under 35 U.S.C. 102(e) and 35 U.S.C. §103(a) under Wiesel and Wiesel in view of Jacobs, respectively. The Examiner cites Wiesel as teaching a unit package for carrying and applying a dental composite, wherein the composite 16 is carried on a carrier film 12 that is covered by a cover 18 which is releasably sealed to the carrier film. The Examiner opines that the carrier film has laterally extending tabs (22 and 24) that are able to wrap around the edges of the teeth with (sic) applied.

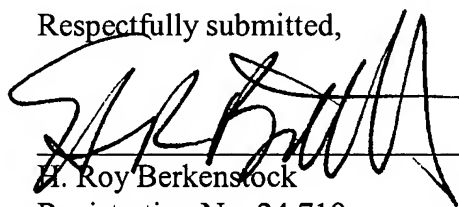
Applicant has amended claims 1 and 13 to define the requisite structure of the carrier film for use in the application of a restorative composite to the surface of a tooth, as compared to Wiesel's teaching of a carrier for a strip of tooth whitener to a tooth, which is later removed from the tooth as by brushing, rinsing or peeling. (see Col 5, lines 41 - 43). In respect of the Examiner's assertion that the tabs 22 and 24 "wrap around the edges of the teeth", Applicant respectfully directs the Examiner to Column 5, lines 21 through 25 wherein it is recited that "surfaces 22 and 24 thereof overlie the surfaces 26 and 28 of a person's gum on the inside and outside of their jaw as shown in FIGS. 2 and 3". Applicant teaches that the lateral embrasure tabs 20 of the unit package are located and sized to be inserted between adjacent teeth, and extend from the enlarged central portion on which the restorative composite is placed. As further explained, the structure and location of the tabs facilitate the placement and dispersion of the restorative over the surface of the tooth, after which, the composite is smoothed by a spatula being manipulated over the film, and avoiding direct contact with the composite. See the Specification generally at pages 10 and 11.

None of the references cited by the Examiner (alone, or in combination) address a unit package for the application of a composite on the surface of a tooth, adapted for the manipulation of the composite in conjunction with the carrier film, and the structural requirements thereof. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Wiesel does not disclose the elements of Applicants package as now claimed. In respect of the rejection of Applicant's claims on the ground of

obviousness, it is important to consider the rules for combining references: a *prima facie* case of obviousness requires three criteria to be met - some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, secondly, there must be some reasonable expectation of success and thirdly, the prior art references must teach or suggest all the claim limitations. See *Teleflex, Inc. v. Fiacosa North America Corp.*, 63 USPQ2d 1374, 1387 (Fed. Cir. 2002); *In re Dembiczak*, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). As now claimed, none of the combinations of references applied by the Examiner meet the *prima facie* test, or, for that matter the combinability tests of *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303, 11 (Fed. Cir. 1983) and *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577 USPQ 929, 933 (Fed. Cir. 1984). The reference Wiesel is directed to application of a tooth whitener substance wherein tabs are applied over the patient's gum, and then removed and the whitener gel is then washed away. Davis and Jacobs are directed to a blister sheet package for such as pills and curable materials, wherein there is no suggestion as to the combinability with special purpose packaging for the application of a composite to the surface of a tooth.

Applicant submits that the claims are now in allowable format and an Allowance is solicited. If the Examiner feels that a telephone conference with Applicant's attorney would advance the prosecution of the application, he is invited to call the undersigned at 901-537-1108.

Respectfully submitted,

  
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